

REMARKS

Claims 1-7 are pending.

In the Office Action, the Examiner has rejected claims 1-7 under 35 U.S.C §103(a) as being unpatentable over United States Patent No. 6,298,348 (Eldering) in view of United States Patent No. 5,734,720 (Salganicoff).

In accordance with MPEP § 2143, for the Examiner to establish a *prima facie* case of obviousness due to a combination of prior art reference teachings the following must be shown:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;*
- (2) a finding that there was reasonable expectation of success; and*
- (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.*

Eldering teaches “the receipt of consumer purchase information with which consumer characterization vectors are updated based on product characterization information” (col. 2, lines 33-36) and “the correlation of an advertisement characterization vector associated with an advertisement with the consumer characterization vector to determine the applicability of the advertisement to the consumer” (col. 3, lines 42-45). This correlation is used by the advertiser “to price access to the consumer based on the degree of correlation of an advertisement with their profile. If an advertisement is found to be very highly correlated with a consumer’s demographics and product preferences, a relatively high price can be charged for transmitting the advertisement to the consumer” (col. 3, lines 48-52).

As discussed in a previous reply, Eldering teaches a system by which the advertiser can mine a database of consumer profiles and identify those consumer profiles to which a given advertisement can be presented, based on some correlation between the advertisement and a profile of the consumer. With reference to FIG. 5, “a correlation request 546 is received by consumer profiling system 500 from advertisement records 540 along with the consumer ID 512” (col. 10, lines 4-7, emphasis added). System 500 then creates a demographic correlation 556 and product correlation 558 which are then used

by “advertiser 144 ... to determine the applicability of the advertisement and to determine if it is worth purchasing the opportunity” (col. 10, lines 15-18, emphasis added).

It will be appreciated therefore that in Eldering it is not the consumer, or the consumer’s profile, that searches through all the advertisements to identify a best match but rather the reverse.

This is not only in sharp contrast with the invention claimed in independent claims 1 and 6, which claim “means for enabling said consumer to select one of said at least one best-matched consumption object to obtain said consumption object” (emphasis added) and the step of “presenting the consumer with a list of best to worst matches ... [and] permitting said consumer to select one of said at least one best-matched consumption object” (emphasis added), respectively, but also in sharp contrast with the teaching of Salganicoff.

More specifically, Salganicoff teaches a system and method using an “agreement matrix” which characterizes the attractiveness of various video programs to a particular customer in order to create a “virtual channel” of recommended programming. As stated at col. 40, lines 6-14, “a customer profile system in accordance with the present invention calculates the agreement matrix at the customer’s set top multimedia terminal from the customer profiles stored [therein] and the content profiles of the received video programming. This technique allows the set top multimedia terminal to create “virtual channels” of the video programming received which the set top multimedia terminal deems most desirable on the basis of the customer’s profile(s)” (emphasis added).

The Examiner has stated that it would have been obvious to one of ordinary skill in the art at the time of invention to modify Eldering to include the teachings of Salganicoff “for the obvious reason for assisting the consumer in selecting the best product available” (p. 4). The Applicant respectfully disagrees. As noted above, the system taught in Eldering enables the advertiser to make a determination as to the “applicability” of a given advertisement to a particular consumer, not the other way around. In other words, Eldering does not assist the consumer in selecting the best product available, but rather assists the advertiser in selecting the best consumer available.

In contrast, the set top multimedia terminal of Salganicoff determines “a subset of available programs ... which is most desirable for viewing by the customer” (col. 5, lines 13-15”, emphasis added).

As such, the Applicant respectfully submits that there no teaching, suggestion, or motivation, in either Eldering, Salganicoff or in the knowledge generally available to one of ordinary skill in the art, to combine or otherwise modify these two references in such a way that renders the subject matter of claim 1 obvious. Moreover, the Applicant respectfully submits that there is no reasonable expectation of success that the teachings of Eldering and Salganicoff could be combined since they approach the problem of matching a consumer and a product (an advertisement or video program) from completely opposite frames of reference.

In addition, it is noted that the Examiner may not use hindsight based on the Applicant's disclosure in order to combine references. As cited at MPEP §2145, "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

In light of the foregoing, the Applicant respectfully submits that the Examiner has failed to establish a *prima facie case* of obviousness and that the rejection of claims 1-7 be withdrawn.

Accordingly, claims 1-7 are believed to be in condition for allowance. Reconsideration of the rejection is requested and allowance of claims 1-7 at an early date is solicited.

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